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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,945	06/22/2001	Sanac Okuyama	SON - 2132	6219

23353 7590 10/18/2006

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WASHINGTON, DC 20036

EXAMINER

MILIA, MARK R

ART UNIT PAPER NUMBER

2625

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/885,945		OKUYAMA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Mark R. Milia		2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Appeal Brief***

1. Applicant's Appeal Brief was received on 7/14/06 and has been entered and made of record. Currently claims 1-7 are pending.

### ***Response to Arguments***

2. Applicant's arguments, see pages 8-18, filed 7/14/06, with respect to the rejection(s) of claim(s) 1-7 under U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the finality of the Office Action dated 12/15/05 has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 6, and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6, and 7 recite the limitation "the game" in the first limitation. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (US 6835135) in view of U.S. Patent No. 6807521 to Kurosawa et al.

Regarding claim 1, Silverbrook discloses a card making device for making character cards wherein said card making device is comprised of the following means: character data storage means for storing data character data consisting of data on said character appearing in a game (see column 2 lines 58-60 and column 4 lines 13-18, reference states that character data is stored on DVD game discs, CD-ROMs, or other conventional memory cartridges, also the print module contains a memory for video game functions), character data extraction means for extracting said specified character data from said character data storage the means (see column 3 line 61-column 4 line 7), character layout information input means for inputting card layout information specifying the card layout, said card layout here indicating a card layout for said character shown in said character data extracted by said character data extraction

means (see column 4 lines 1-7), card display image information generation means for generating card display image information showing a card display image where said character is positioned (see Fig. 11 (50), column 2 lines 53-55, reference shows a video out source for displaying images), said character here indicating a character shown in said character data extracted by said character data extraction means according to said layout information input by said card layout information input means (see column 3 line 61-column 4 line 7), and card display image information output means for outputting card display image information generated by the card display image information generation means to a printer (see Figs. 1 and 11, column 2 lines 35-40, column 3 lines 38-42, and column 3 line 61-column 4 line 7).

Silverbrook does not disclose expressly wherein the character data storage means is located within the card making device.

Kurosawa discloses wherein the character data storage means is located within the card making device (game console) (see Figs. 1 and 2, column 3 lines 55-61, column 3 line 66-column 4 line 19, column 4 lines 33-36, and column 4 line 46-column 5 line 45).

Regarding claims 6 and 7, Silverbrook discloses a card making method and recording medium stored with a program implemented by computer, comprising: storing character data consisting of data on said character appearing in a game (see column 2 lines 58-60 and column 4 lines 13-18), extracting said specified character data (see column 3 line 61-column 4 line 7), inputting card layout information specifying the card layout for said character shown in said extracted character layout for said character

data (see column 4 lines 1-7), generating card display image information showing the card display image placed with said character shown in said extracted character data, according to said input card layout information (see Fig. 11 (50) and column 2 lines 53-55), and outputting said generated card display image information to a printer (see Figs. 1 and 11, column 2 lines 35-40, column 3 lines 38-42, and column 3 line 61-column 4 line 7).

Silverbrook does not disclose expressly wherein the character data storage means is located within the card making device.

Kurosawa discloses wherein the character data storage means is located within the card making device (game console) (see Figs. 1 and 2, column 3 lines 55-61, column 3 line 66-column 4 line 19, column 4 lines 33-36, and column 4 line 46-column 5 line 45).

Silverbrook & Kurosawa are combinable because they are from the same field of endeavor, video game consoles.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the character data storage area located within the game console, as described by Kurosawa, with the system of Silverbrook.

The suggestion/motivation for doing so would have been to provide storing and updating of character data as a game progresses to enhance the interest of the game (see column 1 line 34-column 2 line 11).

Therefore, it would have been obvious to combine Kurosawa with Silverbrook to obtain the invention as specified in claims 1, 6, and 7.

Regarding claim 2, Silverbrook further discloses wherein said character data extraction means extracts said specified character data from said character data storage means when specified conditions in said game are fulfilled (see column 3 lines 61-67).

Regarding claim 3, Silverbrook further discloses wherein said device further comprises a character selection means for selecting said character for said card making, and said character data of said character selected by said character selection means is extracted by said character data extraction means (see column 3 line 61-column 4 line 7).

Regarding claim 4, Silverbrook further discloses wherein said character data is comprised of said character special feature information showing image information for said character and special features of said character (see column 4 lines 1-7).

Regarding claim 5, Silverbrook further discloses wherein said character layout information is information specifying card layout information items showing features of said character shown in said character special feature information and in the card layout of the image shown in image information on said character (see column 3 line 61-column 4 line 7).

**Conclusion**


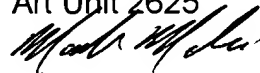
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRM

Mark R. Milia  
Examiner  
Art Unit 2625



**TWYLER LAMB**  
SUPERVISOR, PATENT EXAMINER